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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,958	07/09/2003	Arthur Pennington	35194009008	1273

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EXAMINER	
PHAM, KHANH B	

ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,958	PENNINGTON, ARTHUR	
	Examiner	Art Unit	
	Khanh B. Pham	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed May 30, 2006 has been entered. Claim1 has been amended. Claims 1-20 are pending in this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitting step is the step of creating a transactional report before transmitting the transactional report to a server. Claim 1 recites the step of "transmitting the transactional report to a server" at line 10. However, "the transactional report" has not been created in the previous steps and therefore it is impossible to transmit a non-existent transactional report to a server as claimed. It is noted that the collating step, as amended, only "create collated instruction for creating a transactional report", but does not actually create a transactional report so that it can be transmitted to a server.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Martino (US 5,987,103 A), hereinafter "Martino".

As per claim 1, Martino teaches a self-programming method of creating records of a transaction (See Fig. 1), the method comprising the steps of:

- "receiving user input data from a user input device" at Col. 2 lines 66-67;
- "executing first software instructions such that a Designer implements the user input data, the Designer including supplemental instructions stored therein for use in connection with the user input data" at Col. 2 lines 55-65;
- "collating the user input data with the supplemental instructions to create collated instruction for creating a transactional report" at Col. 2 line 55 to Col. 3 line 19 and Col. 5 lines 50-55;
- "transmitting the transactional report to a server, wherein the server includes at least one direct access memory for pre-storing data" at Col. 3 lines 20-34;
- "executing second software instructions such that the server collates the collated instructions with data pre-stored in the server in order to generate a final report" at Col. 3 lines 20-34;

- "and transmitting the final report to an end user device" at Col. 3 lines 20-34.

As per claim 2, Martino teaches the method of claim 1 wherein "the first software instructions carry out the steps of: (1) defining a form appropriate for the transaction at Col. 9 lines 19-29; (2) defining business rules for the transaction at Col. 22 lines 32-55; (3) defining product calculations for the transaction at Col. 15 lines 43-50; (4) extending a schema to fit the transaction at Col. 14 lines 32-42; and (5) allowing for the previewing of the form as prepared during steps (1-4) at Col. 9 lines 19-39.

As per claim 3, Martino teaches the method of claim 2 wherein "the second software instructions test the final data for accuracy and completeness before transmitting it to the end user device" at Col. 20 lines 50 and Col. 22 lines 25-29.

As per claim 4, Martino teaches the method of claim 1 wherein "the Designer is adapted to receive marketing, actuaries, form design, and procedure design supplied by the human input data instructions" at Col. 16.

As per claim 5, Martino teaches the method of claim 1 wherein "the first software instructions include a capability for designing transaction forms and documents, statements, summaries and reports, and instructions for providing editing and calculating, and work flow rules" at Cols. 15-18.

As per claim 6, Martino teaches the method of claim 1 wherein "the at least one direct access memory stores data relating to an application definition, a transaction definition, document templates, editing and calculating, work flow rules and database schema" at Col. 21 line 12 to Col. 22 line 16.

As per claim 7, Martino teaches the method of claim 1 wherein "the at least one direct access memory stores data relating to a document history, customer history, current customer state, future events, and user tasks" at Col. 21 to Col. 22 line 16.

As per claim 8, Martino teaches a data processing method for causing a computer to produce a document relating to a specific transaction, the method comprising:

- "receiving user input data supplied by an end user from a user input device, the user input data received in a Designer having first data relating to the creation of a computer usable program stored therein" at Col. 7 lines 19-54;
- "generating a transactional report for use by a server, wherein the transactional report is generated using the user input data and the first data" at Col. 9 lines 19-29;
- "transferring the transactional report to the server, wherein the server includes an administration protocol and includes second data relating to specific customer information stored therein" at Col. 7 line 55 to Col. 8 line 55;
- "preparing the computer usable program utilizing the transactional report and the administrative protocol" at Col. 8 lines 7-31 and Col. 10 lines 1-45;

- "collating and assembling information in the transactional report with administrative protocol data and the second data" at Col. 8 lines 7-31;
- "arranging the collated and assembled information for providing a final report; and providing the final report to an end user device" at Col. 8 lines 7-31.

As per claim 9, Martino teaches the method of claim 8 further comprising: "displaying a preview of an output form for the transactional report; and providing for editing of the output form; and providing for approval of the output form prior to be transferred to the server" at Col.18 line 49 to Col. 19 line 50.

As per claim 10, Martino teaches the method of claim 8 wherein "the transactional report generated by the Designer is formed responsive to the initial steps including defining a form, defining work flow rules, defining product calculation and interrogating a database" at Col. 15 lines 20-57.

As per claim 11, Martino teaches the method of claim 10 further comprising: "selecting a subject matter relating to the specific transaction, thereby identifying at least one of an institution, business, fund or organization" at Col. 22 line 32 to Col. 23 line 58.

As per claim 12, Martino teaches the method of claim 11 wherein "the input data includes a name of a financial entity, an amount of money involved in the specific transaction, and details of a specific transaction" at Col. 22 line 32 to Col. 23 line 58.

As per claim 13, Martino teaches the method of claim 8 wherein "the specific transaction involves a buy/sell order and the initial steps include identifying a specific

customer, selecting a financial entity, entry of a number of units bought/sold, and calculating a total price of the units bought/sold" at Col. 23 lines 35-58.

As per claim 14, Martino teaches the method of claim 13 further comprising: "deciding whether to approve or refuse the buy/sell order" at Col. 23 lines 35-58.

As per claim 15, Martino teaches the method of claim 8 further comprising: "verifying that the specific transaction is within parameters of the first data and the second data" at Col. 20 lines 30-50.

As per claim 16, Martino teaches the method of claim 8 further comprising: "defining a payee of any checks or money transfers generated by an approved transaction" at Col. 22 lines 32-64.

As per claim 17, Martino teaches the method of claim 8 further comprising: "identifying a specific customer who provided the input data and requiring the specific customer to authorize a final transaction before completion of the specific transaction" at Col. 23 lines 35-58.

As per claim 18, Martino teaches an apparatus for processing and documenting transactional information, the transactional information relating to any one of many different businesses, the apparatus comprising:

- "an input device capable of receiving a user to input data for processing and documenting the transaction" at Col. 6 lines 4-42;
- "a Designer operably coupled to receive the user input data from the input device, the Designer supplying a form responsive to the user input data and generating a program responsive to the user input data, the program providing at

least one document selected from a group consisting of statements, summaries, and reports relating to the transaction, for implementing and editing of the selected document, for implementing calculations, and for implementing work flow rules" at Col. 14 line 20 to 67;

- "a server operably coupled to the Designer, wherein the server responds to the generated program to generate a document" at Col. 8 lines 10-30;
- "a first memory associated with the server for providing archived matter, the first memory being a repository of pre-stored information for carrying out the generated program, the repository including application definitions, transition definitions, document templates, edits and calculations, work flow rules, and a database schema" at Col. 10 lines 1-55;
- "a second memory associated with the server, the second memory having a repository for receiving input data and for outputting processed data, the repository including a document history, a customer history, a file of current customer state, a file of future events, and a file of user tasks; and a device for transmitting the document as prepared jointly by the Designer and the server over the internet" at Col. 22 line 32 to Col. 23 line 58.

As per claim 19, Martino teaches the apparatus of claim 18 further comprising:

- "a device inter-coupling the Designer and the server, the inter-coupling device comprising a first unit for providing administrative tasks and a second unit for providing customer self-service, the first and second units being responsive to the Designer and to the first and second memories" at Fig. 1;

- "the first unit providing program instructions for handling phone inquiries and transactions, entering data relating to the transactions, auditing customer accounts, verifying and approving transactions, and managing internal work flow" at Col. 16 line 10 to Col. 17 line 21; and
- "the second unit providing program instructions for checking account status, requesting statements, reprinting statements, reviewing transactional history, perform transactions, and scheduling future events" at Col. 22 lines 55-65.

As per claim 20, Martino teaches an apparatus for processing transactional information, the apparatus comprising:

- "a device for receiving user input data relating to a transaction" at Col. 6 lines 4-31;
- "a Designer responsive to the user input data for assembling instructions for creating a pre-program" at Col. 6 lines 32-67;
- "at least a first memory providing a repository of first pre-stored data relating to details of how a program is formed" at Col. 6 lines 43-52;
- "at least a second memory providing a repository of second pre-stored data relating to details of a possible transaction" at Col. 8 lines 10-20;
- "a program generating circuit including an administrative task protocol responsive to the Designer and the memories according to the first and second pre-stored data" at Col. 16 line 10 to Col. 17 line 21; and
- "the program generating circuit also including a customer self-service protocol for converting operations of the Designer, memories, and program generating circuit

administrative task protocol into a computer usable message and transmitting the computer usable message over an internet to an end user" at Col. 16 line 10 to col. 17 line 21.

Response to Arguments

7. Applicant's arguments filed May 30, 2006 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

8. Regarding claim 1, applicant argued that does not teaches the step of "collating the user input data with supplemental instructions for creating a transactional report". In response to applicant's argument, it is noted that the features upon which applicant relies (i.e., "creating a transactional report") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). See also the 35 U.SC 112, 2nd paragraph rejection presented in this Office Action.

9. Regarding claim 8, applicant argued that Martino does not teach or suggest "generating a transactional report for use by a server wherein the transactional report is generated using the user input data and the first data" because "Martino does not have a processor for processing and generating a report". On the contrary, Martino teaches at Col. 9 lines 19-29 that "Data transactions are created by data transaction assembler 18" (See Fig. 1 below), and "A generic data transaction is illustrated in FIG. 2". Further, applicant's specification at [00023] provides: "The Designer 100 provides supplemental information and collates it with the user supplied data in order to **assemble a**

transactional report including an instructional output as well as, in one embodiment, **a form having various data entry fields**" confirms that the claimed "transactional report", in one embodiment, is "a form having various data entry field" similar to Martino's data transactional form A shown at Fig. 2.

FIG.2

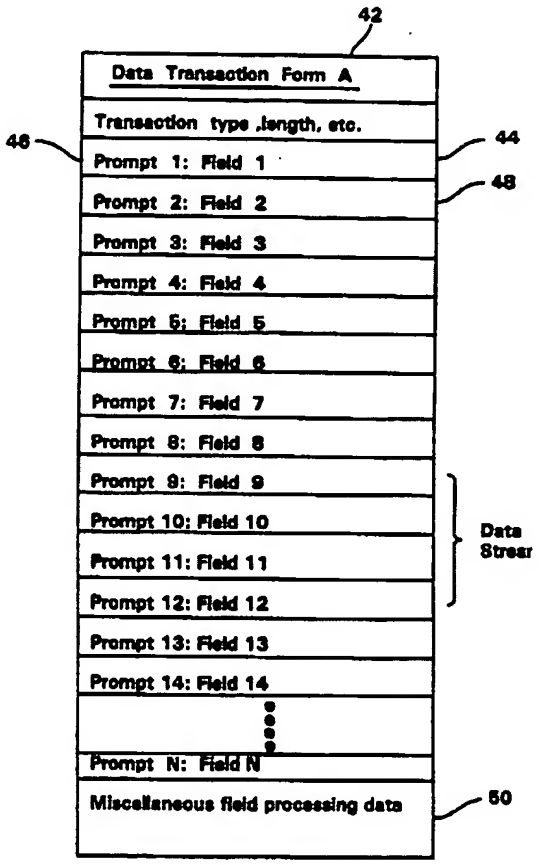
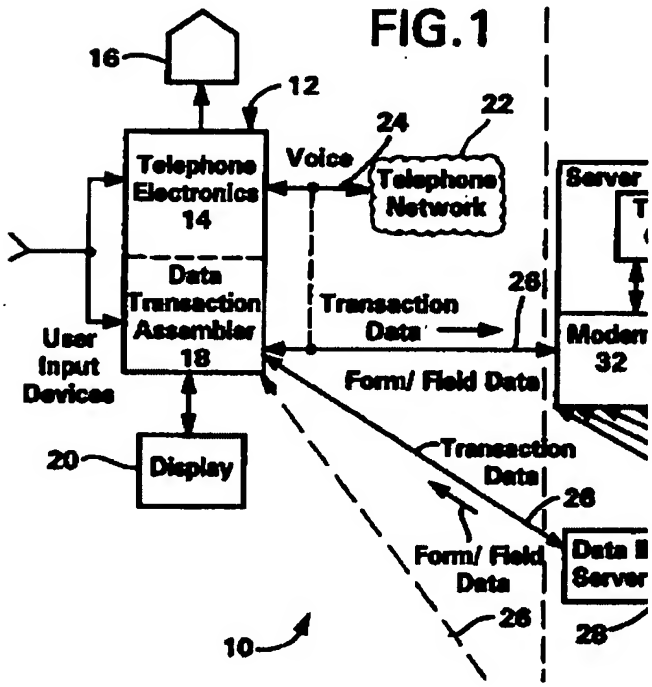


FIG.1



Regarding claim 18, applicant argued that Martino does not teach "a designer operator coupled to received the user input data, the designer supplying a form responsive to the user input and generating a program..." because this function is performed by the server. On the contrary, the functions described at Col. 9 lines 19-30 and Col. 14, lines 20-67 are performed by "**the data transaction assembler 18**", which

does **not** reside on the server, but in the user's telephone device as shown in Fig. 1 above.

In light of the foregoing arguments, the 35 U.S.C 102 rejection is hereby sustained.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Khanh B. Pham
Examiner
Art Unit 2166

August 16, 2006